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EXAMINER
ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		10/082,354	JACOBSEN ET AL.
		Examiner	Art Unit
		Neveen Abel-Jalil	2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 June 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-58</u> is/are pending in the application.

    4a) Of the above claim(s) <u>54-58</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-53</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>6/6/02, 6/14/02, & 5/4/04 & 2/26/02</u>

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Remarks

1.   The Amendment filed on June 28, 2005 has been received and entered. Claims 1-58 are

now pending. Claims 54-58 are non-elected.

Election/Restrictions

2.   Applicant's election without traverse of claims 1-53 in the reply filed on June 28,

2005 is acknowledged.

Specification

3.   The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed. The following title is suggested:

A smart crawler for storing indexes subject-specific filtered relevant sites.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

5.   Claims 3-13, 25, 40, 41, and 45-53 are rejected under 35 U.S.C. 101 because the claims

are directed to a non-statutory subject matter.

6.   Claims 40, 41, and 46 are not limited to tangible embodiments. In view of Applicant's

disclosure, specification page 8, line 24, the medium is not limited to tangible embodiments,

instead being defined as including both tangible embodiments (e.g., magnetic hard disk; a floppy disk; an optical disk) and intangible embodiments (e.g., carrier waves). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejections the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the specification at the bottom, carrier medium and transmission media would be not statutory but storage media would be statutory.

Claims 47-53 are dependent on rejected Independent claim 46 and therefore carry the same deficiencies.

7.   Claims 3-13, 25, 45, 50 and 53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Mental processes and abstract ideas are not patentable. The process of approving by a human editor if contents are deemed relevant or not, is a mental process and/or an abstract idea.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9.   Claims 3-13, 25, 45, 50 and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 3,

25, 45, 50, and 53, the recitation of "human editor ... and human interface" fails enablement

since it's not clear what and how to define human-editor interaction and what constitutes human

results

10.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11.   Claims 1-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claim 1 recites the limitation "the content" in line 4. There is insufficient antecedent

basis for this limitation in the claim. Claim 1 recites the limitation "said subject" in line 4. There

is insufficient antecedent basis for this limitation in the claim.

Claims 2-45 depend on independent claim 1 and therefore carry the same deficiencies.

12.   Claim 46 recites the limitaion "said subject" in line 6. There is insufficient antecedent

basis for this limitation in the claim. Claim 46 recites the limitaion "indexed subject-specific" in

line 9. There is insufficient antecedent basis for this limitation in the claim. The previous

limitaion in claim 46 states "indexing the relevant sites" and not "indexing subject-specific

information".

Claims 47-53 depend on independent claim 46 and therefore carry the same deficiencies.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14.   Claims 1-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Legh-Smith et

al. (U.S. Patent No. 6,178,419 B1).

As to claims 1, 40, and 41, Legh-Smith et al. discloses a method of compiling and

accessing subject-specific information from a computer network, the method comprising the

steps of:

traversing links between sites on the computer network (See Legh-Smith et al. column 9,

lines 23-67, also see Legh-Smith et al. column 5, lines 31-44);

filtering the contents of each site visited to determine relevancy of content to said subject

(See Legh-Smith et al. column 4, lines 47-67, also see Legh-Smith et al. column 5, lines 1-27);

and

presenting for indexing information on each site deemed relevant by said filtering (See

Legh-Smith et al. column 1, lines 23-35, prior art).

As to claims 2, and 24, Legh-Smith et al. discloses further comprising the step of:

filtering the contents of a site at least a second time for relevancy, prior to the step of

presenting (See Legh-Smith et al. column 6, lines 19-23).

As to claims 3, 25, 45, 50, and 53, Legh-Smith et al. discloses wherein at least one of said

filtering steps comprises the steps of:

presenting the contents to a human editor (See Legh-Smith et al. column 8, lines 54-67,

wherein "human editor" reads on "GUI" accessed by user);

approving, by the human editor, if the contents are deemed relevant (See Legh-Smith et

al. column 9, lines 1-16, wherein "approving" reads on "clicking"); and

disapproving, by the human editor, if the contents are not deemed relevant (See Legh-

Smith et al. column 11, lines 47-64, also see Legh-Smith et al. column 12, lines 1-11).

As to claims 4, 14, and 47, Legh-Smith et al. discloses wherein at least one of said

filtering steps comprises the step of:

passing the contents of the site through a lexicon-based filter, the filter comparing

contents of the site with terminology found in the lexicon (See Legh-Smith et al. column 6, lines

55-67, also see Legh-Smith et al. column 7, lines 1-59).

As to claims 5, and 15, Legh-Smith et al. discloses wherein the step of passing the

contents of the site through a lexicon-based filter comprises the steps of:

breaking up a web page corresponding to the site contents into component parts (See

Legh-Smith et al. column3, lines 50-52); and

comparing the contents of each component part with the lexicon (See Legh-Smith et al. column 7, lines 37-59).

As to claims 6, 11, 16, and 21, Legh-Smith et al. discloses wherein the step of passing the contents of the site through a lexicon-based filter further comprises the steps of:

assigning a weight to each component part based on a result of the step of comparing (See Legh-Smith et al. column 5, lines 1-27, also see Legh-Smith et al. column 3, lines 53-54); and

deeming the component part to be relevant if it achieves a high-enough weight (See Legh-Smith et al. column 6, lines 1-18).

As to claims 7, 12, 17, and 22, Legh-Smith et al. discloses wherein the step of assigning a weight comprises the steps of:

assigning a weight to each word, term, or expression in the component part that matches a word, term, or expression in the lexicon, according to a weight associated with the word, term, or expression (See Legh-Smith et al. column 5, lines 1-27); and

accumulating a sum of assigned weights, the sum forming the weight assigned to the component part (See Legh-Smith et al. column 5, lines 1-27).

As to claims 8, 13, 18, and 23, Legh-Smith et al. discloses wherein the step of passing the contents of the site through a lexicon-based filter further comprises the steps of:

saving component parts deemed to be relevant and passing them to the presenting step

(See Legh-Smith et al. column; and

discarding component parts deemed not to be relevant (See Legh-Smith et al. column 12,

lines 1-11).

As to claims 9, and 19, Legh-Smith et al. discloses wherein the step of passing the

contents of the site through a lexicon-based filter further comprises the steps of:

if at least one component part is deemed to be relevant, passing the web page to the

presenting step (See Legh-Smith et al. column 5, lines 45-60, also see Legh-Smith et al. column

6, lines 1-54); and

if no component part is deemed to be relevant, discarding the web page (See Legh-Smith

et al. column 12, lines 1-11, also see Legh-Smith et al. column 6, lines 1-23).

As to claims 10, and 20, Legh-Smith et al. discloses wherein the step of passing the

contents of the site through a lexicon-based filter comprises the step of:

comparing the contents of a web page corresponding to the site with the lexicon (See

Legh-Smith et al. column 6, lines 55-67, also see Legh-Smith et al. column 7, lines 1-59).

As to claim 26, Legh-Smith et al. discloses further comprising the step of:

replacing the lexicon with a lexicon corresponding to a different subject in order to create

a different subject-specific database (See Legh-Smith et al. column 6, lines 55-67, also see Legh-

Smith et al. column 7, lines 1-59).

As to claim 27, Legh-Smith et al. discloses further comprising the step of: compiling a

database of searchable relevant information (See Legh-Smith et al. column 6, lines 25-67, also

see Legh-Smith et al. column 4, lines 23-30).

As to claim 28, Legh-Smith et al. discloses further comprising the steps of:

permitting a user to enter a query; and searching the database for information according

to the query (See Legh-Smith et al. column 5, lines 31-35).

As to claims 29, and 32, Legh-Smith et al. discloses further comprising the step of:

displaying information found in said step of searching in a hierarchical format (See Legh-Smith

et al. column 7, lines 17-35).

As to claim 30, Legh-Smith et al. discloses further comprising the step of:

determining a site ranking for each site associated with information found in said

searching step, where the determining is according to how interesting at least one of authors and

users of the computer network have found the site associated with the information (See Legh-

Smith et al. column 8, lines 54-67, also see Legh-Smith et al. column 9, lines 1-6, and see Legh-

Smith et al. column 11, lines 43-67).

As to claim 31, Legh-Smith et al. discloses further comprising the step of:

displaying the results of the user query using the site ranking of each item of information

found in the search to determine an order in which the results are displayed (See <u>Legh-Smith et</u>

<u>al.</u> column 6, lines 1-44).

As to claim 32, <u>Legh-Smith et al.</u> discloses wherein the step of displaying the results of

the user query comprises the step of:

displaying the results of the user query in a hierarchical format according to site ranking

(See <u>Legh-Smith et al.</u> column 9, lines 38-54, also see <u>Legh-Smith et al.</u> column 7, lines 17-67).

As to claim 33, <u>Legh-Smith et al.</u> discloses wherein the step of compiling a database

comprises the step of:

for each relevant site to be stored in the database, assigning a word score to each word

appearing on that site (See <u>Legh-Smith et al.</u> column 3, lines 36-57, also see <u>Legh-Smith et al.</u>

column 7, lines 60-67, and see <u>Legh-Smith et al.</u> column 8, lines 1-33).

As to claims 34, and 36, <u>Legh-Smith et al.</u> discloses wherein the step of assigning word

scores comprises the steps of:

determining all sites found in the database that contain links to the site (See <u>Legh-Smith</u>

<u>et al.</u> column 4, lines 42-65);

for each word on the site, assigning a word score for that word based at least in part on its

presence on each site containing a link to the site (See <u>Legh-Smith et al.</u> column 3, lines 44-57).

As to claims 35, and 37, <u>Legh-Smith et al.</u> discloses wherein the step of assigning a word

score for that word further comprises the step of increasing the word score for each site

containing a link to the site if the word appears in close proximity to the link (See <u>Legh-Smith et</u>

<u>al.</u> column 3, lines 44-49).

As to claim 38, <u>Legh-Smith et al.</u> discloses further comprising the steps of:

entering a user query (See <u>Legh-Smith et al.</u> column 5, lines 31-65);

using the user query to search the database (See <u>Legh-Smith et al.</u> column 6, lines 24-54,

also see <u>Legh-Smith et al.</u> column 5, lines 31-65); and

computing a site ranking for each site associated with information found in said searching

step, the site ranking being computed based on said word scores (See <u>Legh-Smith et al.</u> column

3, lines 36-57, also see <u>Legh-Smith et al.</u> column 7, lines 60-67, and see <u>Legh-Smith et al.</u>

column 8, lines 1-33).

As to claim 39, <u>Legh-Smith et al.</u> discloses wherein the step of computing a site ranking

comprises the steps of:

for each site associated with information found in said searching step, summing the word

scores for that site corresponding to words in the user query (See <u>Legh-Smith et al.</u> column 6,

lines 24-54, also see <u>Legh-Smith et al.</u> column 5, lines 31-65).

As to claim 42, <u>Legh-Smith et al.</u> discloses further comprising the step of: monitoring a

depth for each link, the depth being a reflection of relevance (See <u>Legh-Smith et al.</u> column 11,

lines 1-46).

As to claim 43, Legh-Smith et al. discloses wherein the step of monitoring comprises the

steps of:

for a given site being visited, setting depths of any links leading from that site to other

sites to a depth of a link traversed to reach the given site (See Legh-Smith et al. column 9, lines

23-48);

if the given site is determined to be relevant in the filtering step, setting the depths of the

links leading from that site to zero (See Legh-Smith et al. column 12, lines 1-11, also see Legh-

Smith et al. column 11, lines 5-46); and

if the given site is determined not to be relevant in the filtering step, incrementing the

depths of the links leading from that site (See Legh-Smith et al. column 12, lines 1-11, also see

Legh-Smith et al. column 11, lines 5-46).

As to claim 44, Legh-Smith et al. discloses wherein the step of monitoring further

comprises the steps of:

comparing the incremented depths to a predetermined maximum depth value (See Legh-

Smith et al. column 10, lines 4-67);

if the incremented depths exceed the predetermined maximum depth value, discarding the

links leading from the given site (See Legh-Smith et al. column 12, lines 1-11);

if the incremented depths do not exceed the predetermined maximum depth value,

traversing one of the links leading from the given site (See Legh-Smith et al. column 7, lines 17-

35).

As to claim 46, Legh-Smith et al. discloses a system that compiles and permits accessing

of subject-specific information from a computer network, the system comprising:

a host computer executing software from a computer-readable medium (See Legh-Smith

et al. column 4, lines 31-46), the software comprising:

a smart crawler for traversing the computer network (See Legh-Smith et al. column 5,

lines 36-44, also see Legh-Smith et al. column 1, lines 23-35, prior art);

a first filter, filtering out sites that are irrelevant to said subject, and permitting only

relevant sites to pass (See Legh-Smith et al. column 5, lines 45-60); and

an indexer indexing the relevant sites (See Legh-Smith et al. column 1, lines 23-40, prior

art, also see Legh-Smith et al. column 2, lines 34-64, also see Legh-Smith et al. column 7, lines

17-35); and

memory, connected to the host computer, for storing indexed subject-specific information

(See Legh-Smith et al. column 5, lines 61-67, also see Legh-Smith et al. column 6, lines 1-7, also

see Legh-Smith et al. column 6, lines 25-54).

As to claims 48, and 52, Legh-Smith et al. discloses wherein the system further

comprises an interchangeable computer-readable medium on which is stored the lexicon for the

lexicon-based filter, the lexicon containing subject-specific terminology (See Legh-Smith et al.

column 6, lines 55-67, also see Legh-Smith et al. column 7, lines 1-59).

As to claims 49, and 51, <u>Legh-Smith et al.</u> discloses wherein the software further

comprises at least a second filter (See <u>Legh-Smith et al.</u> column 6, lines 19-24).

Response to Arguments

15.   Applicant's arguments with respect to claims 1-53 have been considered but are moot in

view of the new ground(s) of rejection.

In response to applicant's request to withdraw the 35 USC 101 rejections for claims 3,

25, 45, 50 and 53 is acknowledged but not deemed to be persuasive.

The Examiner points to the recitation of claim 3 of "a method of filtering ...comprises

steps of... human editor" and nothing more clearly without the need for a computer to implement

the method. Mental processes need to be presented and carried on a physical device (i.e. user

interface).

The Examiner points to the recitation of claims 25, 45, 50, and 53 of "human interface...

and human editor" renders the claim non-statutory since it removes the process form taking place

on a computer to taking place abstractly using mental process. Implementing a filter for

presenting content to the user using an interface is statutory. However, defining the interface to

be a human interface renders the claim non-statutory.

A human editor is a disembodied concept, which may be characterized as an abstract

idea, and not a specific machine to produce a useful, concrete, and tangible result. (*State Street*,

149 F.3d at 1373, 47 USPQ2d at 1601).

In response to applicant's argument that a dependent claim on a statutory independent claim renders the claim statutory " is acknowledged but not deemed to be persuasive.

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. _Schrader_, 22 F.3d at 296, 30 USPQ2d at 1460.

The dependent claims of a process (i.e. method) are further limiting to the invention; in their addition, can change the invention. Therefore, it is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.

The utility specified for the invention defined in a dependent claim differs from that indicated for the invention defined in the independent claim from which the dependent claim depends and now renders the dependent claim non-statutory.

Conclusion

16.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pitkow et al. (U.S. Pub. No. 2002/0016786) teaches smart search engine using weighted category recommendation.

Liddy et al. (U.S. Patent No. 6,304,864) teaches subject categories crawlers.

17.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5: 30PM EST.

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

    Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHARLES RONES
PRIMARY EXAMINER

Neveen Abel-Jalil
September 8, 2005